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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,808	04/08/2005	Armin Kuebelbeck	LEIF-8	9483
23599 7590 09/06/2007 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EXAMINER LE, HOA T	
			ART UNIT 1773	PAPER NUMBER
			MAIL DATE 09/06/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<div style="border: 1px solid black; width: 150px; height: 20px; margin: 0 auto;"></div> <p style="text-align: center;"><b>Office Action Summary</b></p>	<b>Application No.</b> 10/530,808	<b>Applicant(s)</b> KUEBELBECK ET AL	
	<b>Examiner</b> H. T. Le	<b>Art Unit</b> 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>April 2005</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____<br>5) <input type="checkbox"/> Notice of Informal Patent Application<br>6) <input type="checkbox"/> Other: ____ |
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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 17 is rejected under 35 USC 101. The claim as described is inoperative and therefore lacks utility. Claim 17 is directed to a method of use but no positive steps are described. Thus claim is inoperative. Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 3, "layer" has no proper antecedent basis.

Claim 2 is confusing as it is inconsistent with claim 1. Claim 1 requires that the pigment consisting of a substrate/core and a coating. Claim 2 appears to preclude coating with the claim language "consists of".

In claim 10, the medium for the pH reduction is not stated. Also, "the organic constituents" has no clear antecedent basis. Similarly, "steps one and two" has no clear antecedent basis as only first and second step are previously described.

Claim 14 is unclear with regard to the medium of the pH that is being reduced. In claim 15, "the polycondensation" has no clear antecedent basis.

Claim 17 is indefinite because the claim merely recites a use without any active, positive steps delimiting how this use is actually practiced. Ex parte Erlich, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986). See MPEP 2173.05(q).

In claim 18, "the nonflake coated carrier materials" has no antecedent basis. No carrier materials are recited in claim 1.

In claim 19, "this invention" renders claim indefinite. In addition, "carrier materials" is unclear.

Other claims are deemed indefinite in view of their dependency on claim 1 or 10.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-19 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1-24 of

copending Application No. 10/506,326. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the only difference between

the instant claims and the referenced claims is that the pigments of the instant claims

are described at "non-flake" while those of the referenced claims are recited as "flake".

However, one having ordinary skill in the art would have found it obvious to use flakes if

naceous color effects instead of lustrous color effects because shapes of pigments that

influence the color effect are widely known in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 6-8, 10, 11 and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by the German patent DE 4 317 019 ("DE'019) or the Japanese patent JP 06-032996 (JP'996).\*

Claim 1: DE'019 and JP'996 teach a pigment comprising a core particle coated with melamine resin. See abstract.

Claim 2: DE'019 and JP'996 suggests several pigments as the core which include red oxide which is the iron(III)hexacyanoferrate recited in claim 2. See in particular, JP'996, par. [0017] where pigments taught in US 4,373,963 are suggested. US 4,373,963 suggests red iron oxide (i.e. iron ferrate) at col. 3, lines 47-61.

Claims 6-8: Modified melamine resin is taught. See JP'996, [0019] and [0024].

Claim 10: The coating is formed by curing, i.e. crosslinking reaction. See JP'996, examples.

Claims 11, 15 and 16: .See JP'996, [0019] and [0024].

Claim 14: pH reduction is taught at [0025] in JP'996.

Claims 17-19: See abstract.

9. Claims 1, 10 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah et al (US 5,962,134).

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\* The DE'019 is an equivalent document of JP'996; therefore, citations from JP'996 are used in the rejection and serve as the translation of DE'019.

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Claim 1: Shah teaches a coated colored particle comprising a core which may be organic or inorganic and a coating of melamine-formaldehyde resin. See col. 2, lines 25-35. The particle is colored particle and thus is a pigment. Col. 2, lines 36-39.

Claim 10: see examples.

Claims 17-19: col. 2, lines 36-39.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-9 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the German patent DE 4 317 019 ("DE'019) or the Japanese patent JP 06-032996 (JP'996) as applied to claims 1, 2, 6-8, 10, 11 and 15-19 above, and further in view of Crews et al (US 5,795,507).

Claims 3-8: DE '019 and JP'996 each disclose the claimed coated pigment as discussed above; however, no dyes or modifying groups in the melamine resin coating are articulated. Crews teaches that dyes combined with methylolmelamine gives excellent hue stability. See Crews, col. 1, lines 55-56. Therefore, one having ordinary skill in the art would have found it obvious to add dyes and methylolamine to the coating layer in the coated pigment of DE '019 or JP'996 in order to provide hue stability to the coating resin as suggested by Crews.

Claim 9: fluorescent dyes are suggested by Crews at col. 3, lines 10-18.

Claims 11-16: See rejections to claims 3-9 above.

12. Claims 2-9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah et al (US 5,962,134) as applied to claims 1 and 10 above, and further in view of Crews et al (US 5,795,507).

Claim 2: The inorganic core as taught by Shah would have encompassed inorganic oxides as recited in claim 2 because Shah suggests that all inorganic oxides are functionally equivalent as the core of the coated pigment.

Claims 3-8: Shah discloses the claimed coated pigment as discussed above; however, no dyes or modifying groups in the melamine resin coating are articulated. Crews teaches that dyes combined with methylolmelamine gives excellent hue stability. See Crews, col. 1, lines 55-56. Therefore, one having ordinary skill in the art would have found it obvious to add dyes and methylolamine to the coating layer in the coated pigment of Shah in order to provide hue stability to the coating resin as suggested by Crews.

Claim 9: fluorescent dyes are suggested by Crews at col. 3, lines 10-18.

Claims 11-16: See rejections to claims 3-9 above.

Claims 17-19: The use of the coated particle as pigment is taught by Shah at col. 2, lines 36-39.

#### ***Information Disclosure Statement***

13. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2)



requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

14. The Jacobson patent (US 5,562,978) -cited as an X-reference against instant claims 1 and 10 in the International Search Report- is considered relevant art of interest. The Jacobson patent teaches organic fibers comprising inorganic particles coated with a resin.

15. Other references are cited as art of interest.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511.

The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. Thi Le/  
H. (Holly) T. Le  
Primary Examiner  
Art Unit 1773

September 2, 2007